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William W. Haefliger
Suite 512
201 So. Lake Ave.
Pasadena CA 91101

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OFFICE OF PETITIONS

In re Application of :
Dilmore, et al. :
Application No. 10/039,811 : ON PETITION
Filed: January 8, 2002 :
Attorney Docket No. 12,105-1 :
For: METAL CONSOLIDATION PROCESS :
APPLICABLE TO FUNCTIONALLY GRADIENT
MATERIAL (FGM) COMPOSITIONS OF
TANTALUM AND OTHER MATERIALS

This is a decision on the petition under 37 CFR 1.137(a), filed September 9, 2004 (certificate of mailing date September 3, 2004), to revive the above-identified application.

The petition is **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to timely submit a complete reply to the Notice of Allowance and Fee(s) Due, mailed September 23, 2003, which set a period for reply of three (3) months.

The Office mailed a Notice of Allowance and Fee(s) Due with Part B - Fee(s) Transmittal, a Determination of Patent Term Adjustment under 35 U.S.C. 154(b), a Notice of Fee Increase on January 1, 2003, and a Notice of Allowability on May 9, 2003.

On June 2, 2003, petitioner filed an improper CPA and preliminary amendment. The CPA was improper because it is not possible to file a CPA in an application filed after May 29, 2000. The improper CPA was treated as a Request for Continued Examination and prosecution was reopened.

On July 17, 2003 (certificate of mail date July 10, 2003) petitioner submitted a completed Part B - Fee(s) Transmittal and the issue fee and publication fee. However, at this time, prosecution was reopened. The fees submitted were treated as inactive because prosecution had been reopened.

The examiner reviewed the June 2, 2003 RCE and preliminary amendment and mailed a new Notice of Allowance and Fee(s) Due with Part B - Fee(s) Transmittal, a Determination of Patent Term Adjustment under 35 U.S.C. 154(b), a Notice of Fee Increase on October 1, 2003, and a Notice of Allowability on September 23, 2003. The Notice of Allowance and Fee(s) Due required petitioner to submit a completed Part B-Fee(s) Transmittal by December 23, 2003. The Notice of Fee Increase on October 1, 2003 informed petitioner that effective October 1, 2003, the issue fee would increase from $1,300 to $1,330. No reply was received. This application became abandoned on December 24, 2003. A Notice of Abandonment was mailed on February 25, 2004.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks item (1) and (3).

Regarding (1) above, petitioner has not submitted a completed Part B - Fee(s) Transmittal from the September 23, 2003 mailing.

While the fee due is listed as $0 on the September 23, 2003 Notice of Allowance and Fee(s) Due, the Notice of Fee Increase mailed concurrently explains that if the response required by the September 23, 2003 mailing is submitted after October 1, 2003, the issue fee will increase to $1,330. The Office applied the inactive $1,300 issue fee paid on July 17, 2003 (certificate of mailing date July 10, 2003) toward the current issue fee owed in reply to the September 23, 2003 Notice of Allowance and Fee(s) Due. However, because petitioner did not submit a completed Part B- Fee(s) Transmittal on or before October 1, 2003, after October 1, 2003 petitioner owed an additional $30 towards full payment of the then-current issue fee ($1,330). Had petitioner submitted a completed Part B- Fee(s) Transmittal on or before October 1, 2003, petitioner would not owe additional money.

Pursuant to petitioner's authorization, $30 will be charged to deposit account no. 08-0118.

Regarding (3) above, petitioner has not shown to the satisfaction of the Commissioner that the entire delay from the due date of the reply to the filing of a grantable petition was unavoidable.

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 USC § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word unavoidable ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Petitioner believed that the July 17, 2003 response to the May 9, 2003 Notice of Allowance and Fee(s) Due and associated documents was sufficient and that the September 23, 2003 Notices and associated documents were redundant. Petitioner failed to realize that the improper CPA and preliminary amendment filed on June 2, 2003 would reopen prosecution and, in effect, void the requirements found in the May 9, 2003 Notices. The September 23, 2003 Notices and associated documents allowed the application, closed prosecution, and re-set requirements.

The September 23, 2003 Notice of Allowance and Fee(s) Due states that the PTOL-85B ("Part B-Fee(s) Transmittal") or an equivalent **must** be returned within the set three month period even if no fee is due or the application will be regarded as abandoned. If a response was filed after October 1, 2003, the issue fee due increased from $1,300 to $1,330. Petitioner did not respond.

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

**ALTERNATE VENUE**

Petitioner is encouraged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required $1,370.00 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b). For petitioner's convenience, a blank PTO/SB/64 -- Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b).

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3230.

E. Shirene Willis

E. Shirene Willis
Petitions Attorney
Office of Petitions

enclosures: blank PTO/SB/64 -- Petition for Revival of an Application Abandoned Unintentionally under 37 CFR 1.137(b)

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